



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/196,029 | 11/19/98 | NEMOTO | H TRW(VSSIM)24 |

PM82/1105
STEPHEN D SCANLON
TAROLLI SUNDHEIM COVELL TUMMINO & SZABO
1111 LEADER BUILDING
526 SUPERIOR AVENUE
CLEVELAND OH 44114-1400

EXAMINER

DICKSON, P

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 11/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/196,029

Applicant(s)

NEMOTO, HIROSHI

Examiner

Paul N. Dickson

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 1999.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 16-18 is/are allowed.
- 6) ☒ Claim(s) 11-15 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

Art Unit: 3618

DETAILED ACTION

1. The indicated allowability of claims 21-23 is withdrawn in view of improper recapture and the indicated allowability of claims 11-15 and 19-23 is withdrawn in view of the newly discovered reference(s) to JP 5-10124. Rejections based on the newly cited reference(s) follow.

2. Claims 21-23 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 21-23 are broader than any of the original claims by the omission of at least one of the following limitations which were surrendered in the application for the patent:

- a. the limitation that the first and second tear seams in the horn switch are aligned with the tear seam in the cover and have a combined length less than the length of the tear seam in the cover (claim 1);

Art Unit: 3618

b. the limitation that the first and second layers of the horn switch have first and second tear lines aligned with the tear seam in the cover, and the second tear line being spaced apart from the first tear line along a line extending along the first and second tear lines (claim 6); and

c. the limitation that the horn switch includes an envelope of electrically insulating material enclosing the first and second layers (claim 9).

With respect to **a.**, the record constitutes an admission by the applicant that the limitation was necessary to overcome the prior art. Reference is made to the amendment filed December 11, 1995, page 3, 1st full paragraph. Reference is also made to the interview summary dated November 29, 1995.

With respect to **b.**, the record constitutes an admission by the applicant that the limitation was necessary to overcome the prior art. Reference is made to the amendment filed December 11, 1995, page 6, 1st full paragraph. Reference is also made to the interview summary dated May 23, 1996.

With respect to **c.**, the record constitutes an admission by the applicant that the limitation was necessary to overcome the prior art. Reference is made to the amendment filed December 11, 1995, page 8, 1st full paragraph, and the paragraph 4 of the Office action mailed September 6, 1995.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3618

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-15 and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 5-10124.

JP 5-10124 discloses an apparatus as claimed comprising: a cover wall 17 having a tear seam 20; and a horn switch 19, 27, 28, 29 including first and second overlying layers 25 (figs. 3-5 and 10) of electrically conductive material having first and second tear seams 27a, 28a, 29a, the horn switch further including an envelope 26 of electrically insulating material with openings (figs. 1, 7 and 9).

Allowable Subject Matter

5. Claims 1-10 and 16-18 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul N. Dickson whose telephone number is (703) 308-2089. The examiner can normally be reached on 7:30-4:00, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1134.

Application/Control Number: 09/196,029

Page 5

Art Unit: 3618



Paul N. Dickson
Primary Examiner
Art Unit 3618

11/7/99

pnd
November 4, 1999